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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,673

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Hajime Sasaki

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REED SMITH LLP

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EXAMINER

QAYYUM, ZESHAN

ART UNIT

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3685

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,673	Applicant(s) SASAKI ET AL.	
	Examiner ZESHAN QAYYUM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-4 have been examined.

Response to Arguments

2. Applicant's arguments filed 05/08/2009 have been fully considered but they are not persuasive. Applicant is of the opinion that prior art does not disclose: "a managing server which stores a patient's medical information transmit to a requester download permission key data for downloading the patient's medical information in the managing server, the requester returns the download permission key data to the managing server, and the managing server authenticates validity of the download transmission key data transmitted from the requester and transmits from the managing server to the requester a permission response for transmitting the medical information of the patient to said management server" While the claims are silent about who is performing the receiving request, transmitting upload/download permission key data, and authenticating validity of said upload/download permission, The Examiner for the purposes of examination interpret as managing server is receiving the request..., patient terminal transmitting the permission key data to the medical institution terminal... and managing server authenticates validity of the upload/download permission key data.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

Art Unit: 3685

In this particular case, claims fail prong (1) because the “tie” (e.g. transmitting said upload permission key data from said medical institution terminal to the managing server) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 state “receiving a request from a patient terminal ...”, “transmitting upload permission key data...” and “authenticating validity of said upload permission key data...” It is unclear to one of the ordinary skills who are performing receiving, transmitting and authenticating steps for example server, patient terminal or medical institution terminal.
7. Claim 2-4 state “receiving a medical information download request...”, “transmitting download permission key data...”, “receiving a permission response for ...” and “authenticating validity of said download permission key...” It is unclear to one of the ordinary skills who are performing receiving, transmitting,

Art Unit: 3685

receiving and authenticating steps for example server, patient terminal or medical institution terminal.

8. The claims 1-4 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne (US 5867821) in view of Rozen (US 6073106).**

10. With respect to claims 1-4, Ballantyne discloses Patient terminal, medical institution terminal (i.e. clinics) (See column 6, lines 47-57 and Fig 1) management server (i.e. Master library) (See column 4, lines 1-3, column 6, lines 32-35 and Fig 1 and 2) medical information storage device (See column 4, lines 4-15 and column 6, lines 20-31) management information control device (See column 7, lines 16-22) Ballantyne also discloses receiving a request from a patient terminal of a first patient among the plurality of patients to upload/download in said management server (i.e. ML) medical information of

Art Unit: 3685

said first patient managed by a medical institution among said plurality of medical institutions (See column 7 lines 66-67 and column 8, lines 1-5) Ballantyne does not explicitly disclose: transmitting upload permission key data for uploading said medical information of said first patient in said management server and a content of said medical information of said first patient to be uploaded by the request to said medical institution terminal of said medical institution from the managing server; transmitting said upload permission key data from said medical institution terminal to the managing server ; upon receiving said upload permission key data transmitted from said medical institution terminal to the managing server, authenticating validity of said upload permission key data with the managing server, transmitting from the managing server to said medical institution terminal a permission response for transmitting said medical information of said first patient to said management server, and deferring upload of said medical information of said first patient in the managing server; and upon receiving said medical information of said first patient transmitted from said medical institution terminal, storing said medical information of said first patient in said medical information storage device.

Rozen discloses: transmitting upload permission key data for uploading said medical information of said first patient in said management server and a content of said medical information of said first patient to be uploaded by the request to said medical institution terminal of said medical institution from the managing server; transmitting said upload permission key data from said medical institution

Art Unit: 3685

terminal to the managing server ; upon receiving said upload permission key data transmitted from said medical institution terminal to the managing server, authenticating validity of said upload permission key data with the managing server, transmitting from the managing server to said medical institution terminal a permission response for transmitting said medical information of said first patient to said management server, and deferring upload of said medical information of said first patient in the managing server; and upon receiving said medical information of said first patient transmitted from said medical institution terminal, storing said medical information of said first patient in said medical information storage device. (See column 5, lines 42-47, and column 7, lines 15-67). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention was made to modify Ballantyne reference with Rozen in order to provide data security.

In addition the claim stated the language "upon". However these are conditionals languages and it has been held that conditional languages do not narrow the claims because they can be omitted. According to MPEP "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP §2106 II. C).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685